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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* FREDRIC NADEL, MOSHE MICHAEL SIEGEL,  
and QIANLI FU

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Appeal 2015-001079  
Application 12/623,986  
Technology Center 3700

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Before LYNNE H. BROWNE, WILLIAM A. CAPP, and  
ERIC C. JESCHKE, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the non-final rejection of claims 1, 3–8, 10–18, and 20–25. We have jurisdiction under 35 U.S.C. § 6(b).<sup>1</sup>

We AFFIRM, but designate our affirmance as a NEW GROUND OF REJECTION pursuant to our discretionary authority under 37 C.F.R. § 41.50(b).

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<sup>1</sup>This matter came before the Board for a regularly scheduled oral hearing April 19, 2017.

## THE INVENTION

Appellants' invention relates to cooling/heating units. Spec. 1.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A wall or window casing for securing a heating/cooling unit comprising:  
a top side;  
a bottom side;  
a first lateral side orthogonally formed to the top side and bottom side; and  
a second lateral side parallel to said first lateral side;  
wherein each of said top side, bottom side, first lateral side and second lateral side is double walled to have a first wall comprising an inner wall and a second wall separate from the first wall, said second wall comprising an outer wall, and a space between the inner wall and the outer wall, and said casing further comprising an insulating material located in the space between the inner wall and the outer wall, and wherein the inner wall of each side forms an opening configured to removably receive the heating / cooling unit.

## THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

|         |                    |                |
|---------|--------------------|----------------|
| Smith   | US 3,308,634       | Mar. 14, 1965  |
| Nervina | US 4,840,041       | June 20, 1989  |
| Yazawa  | JP 2000-055403     | Feb. 25, 2000  |
| Duncan  | US 2006/0201089 A1 | Sept. 14, 2006 |
| Ha      | US 2007/0039342 A1 | Feb. 22, 2007  |

The following rejections are before us for review:

1. Claims 1, 3–6, 8, 10, 12, 14–16, and 20–25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ha and Yazawa.
2. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ha, Yazawa, and Nervina.

3. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ha, Yazawa, and Smith.

4. Claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ha, Yazawa, and Smith.

## OPINION

### *Unpatentability of Claims 1, 3–6, 8, 10, 12, 14–16, and 20–25 over Ha and Yazawa*

#### *Claim 1*

The Examiner finds that Ha discloses the invention substantially as claimed except for the casing being double walled and sandwiching insulation material therebetween. Non-Final Action 2–3. The Examiner relies on Yazawa for this feature and concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ha to include a double-walled, insulated casing as taught by Yazawa. *Id.* According to the Examiner, a person of ordinary skill in the art would have done this to mitigate vibration noise. *Id.*

Appellants traverse the Examiner’s rejection by arguing that Yazawa’s double-walled component is part of the air-conditioner unit rather than a casing.

[T]he sandwich panel of Yazawa forms the outer part of the air conditioner. Indeed, the title of Yazawa is “a sandwich panel for air conditioner” and the industrial application is a “sandwich panel used for the outer casing of an air conditioner, etc.” . . . If Yazawa taught an air conditioner casing as defined by the present claims, it would discuss the use of the casing in a wall or window opening. However, Yazawa makes no mention of a wall or window opening. Quite simply, Yazawa does not teach a wall or window casing (as claimed), but an air conditioner having an outer casing that includes a sandwich panel.

Appeal Br. 4 (emphasis omitted). Similarly, Appellants argue that Yazawa does not teach or suggest that a casing (that receives the air conditioner) can be double-walled, as claimed. Reply Br. 2.

Appellants' arguments focus on whether Yazawa is a sandwich panel "for" or "of" an air conditioner. *Id.* According to Appellants, any ambiguity in Yazawa's language favors Appellants' position. *Id.* at 1. Appellants contend that "[t]o the extent the teachings of Yazawa are unclear, the Examiner has failed to carry that burden and the rejection should be reversed." *Id.*

The structure of Yazawa's panel is illustrated in Drawing 3. Drawing 3 shows an inner plate 2 and an outer plate 4. Interposed between the two plates is foam 14. *Id.* Drawing 3; ¶¶ 4–6. The completed panel is attached to frame 12 of an air conditioner by means of screws 13. *Id.* Abstract, ¶ 6. In the English language abstract of Yazawa, the sandwich panel is described as a "sandwich panel used for a face board or the like of an air conditioner." In the machine-generated translation of the body of the text of Yazawa, the invention is described as relating to the sandwich panel for the outer casing of an air conditioner. *Id.* ¶ 1. Elsewhere, it is described as a "sandwich panel for air conditioners." *Id.* ¶¶ 3, 4.

We reject Appellants' contention that the Examiner has failed to make out a prima facie case of obviousness based on an alleged ambiguity regarding whether Yazawa's structure is "for" or "of" an air conditioner. It is well established that, as persons of scientific competence in the fields in which they work, examiners are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art and the motivation those references would

provide to such persons. *In re Berg*, 320 F.3d 1310, 1315 (Fed. Cir. 2003). Absent legal error or contrary factual evidence, those findings can establish a prima facie case of obviousness. *Id.* The controversy over “for” and “of” relates to the accuracy of a machine translation of a Japanese reference. We view the Examiner’s findings as being informed by a reading of the entire disclosure of Yazawa, including an analysis of the drawings that accompany the text of the disclosure. Taking the teachings of Yazawa, as a whole, we are not persuaded that the Examiner erred in finding that Yazawa’s structure is, or is at least capable of being used as, a window or wall casing rather than an integral component of a completed air conditioner unit. Under the particular facts of this particular case, we accord little weight to a machine translation generating a preposition as “for” or “of” when translating from Japanese to English.<sup>2</sup>

Furthermore, the Examiner makes clear that Yazawa is only cited as teaching the concept of double-walled insulation. Ans. 13. Whether Yazawa is directed to a wall or window casing that receives a completed air conditioner unit or is directed to a completed air conditioner unit with a double-walled, insulated outer housing, it still is useful for teaching the use of insulated sandwich walls in conjunction with window or wall air conditioning installations. It is well established that it is not necessary for the prior art to serve the same purpose as that disclosed in Appellants’ Specification in order to support the conclusion that the claimed subject matter would have been obvious. *See In re Lintner*, 458 F.2d 1013, 1016

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<sup>2</sup>There is no indication in the record that Appellants made any effort to obtain their own translation of Yazawa by a qualified, competent human translator.

(CCPA 1972). “A reference may be read for all that it teaches, including uses beyond its primary purpose.” *In re Mouttet*, 686 F.3d 1322, 1331 (Fed. Cir. 2012), *citing KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–421 (2007). Similarly, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *KSR*, 550 U.S. at 417. In this case, there is an opening in a wall or window to receive an air conditioning unit. Under the Examiner’s proposed combination, interposed between the fenestration opening and the wall or window frame will be a double-walled, insulated casing as claimed because Ha teaches a casing which is modified by Yazawa to have a double-walled, insulated sandwich structure.

Appellants next argue that Yazawa teaches away from placing a double-walled panel into a sleeve by instead placing the double-walled panel in the air conditioner itself. Appeal Br. 6. This argument is not persuasive of Examiner error. A reference does not teach away if it merely discloses an alternative invention but does not “criticize, discredit, or otherwise discourage” investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Appellants have not directed us to any language in Yazawa that criticizes, discredits, or otherwise discourages investigation into using double-walled, insulated structure for a wall or window casing.

We have considered Appellants’ remaining arguments and find them to be being without merit. In view of the foregoing discussion, we determine the Examiner’s findings of fact are supported by a preponderance of the evidence and that the Examiner’s legal conclusion of unpatentability

is well-founded. Accordingly, we sustain the Examiner's unpatentability rejection of claim 1. However, because our underlying fact finding, reasoning and analysis differs somewhat from the Examiner's final rejection, we designate our affirmance as a NEW GROUND OF REJECTION pursuant to our discretionary authority under 37 C.F.R. § 41.50(b).

*Claims 3–6, 12, 14–16, 20, 23, and 25*

Appellants do not argue for the separate patentability of claims 3–6, 12, 14–16, 20, 23, and 25 apart from arguments presented with respect to claim 1, which we have previously considered. Consequently, we sustain the rejection of claims 3–6, 12, 14–16, 20, 23, and 25 and, for the same reasons expressed above, hereby designate our affirmance as a NEW GROUND OF REJECTION. *See* 37 C.F.R. § 41.37(c)(iv) (failure to separately argue claims); 37 C.F.R. § 41.50(b).

*Claims 8, 10, 21, 22, and 24*

*Claim 8<sup>3</sup>*

Claim 8 depends from claim 1 and adds the limitation: “wherein said casing is received in a house wall or window opening.” Claims App. Appellants argue that “the prior art does not teach a double-walled casing that is received in a house wall or window opening. If anything, the

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<sup>3</sup> Our governing rule requires that an Appeal Brief set forth separate arguments for patentability under either separate headings or sub-headings. *See* 37 C.F.R. § 41.37(c)(iv) (“any claims(s) argued separately or as a subgroup shall be argued under a separate subheading that identifies the claims(s) by number”). In that regard, the Appeal Brief does not conform to our rules as Appellants argue all grounds of rejection and all claims of all grounds under rejection under a single heading without providing any subheadings. Nevertheless, Appellants devote individual paragraphs within the body of the argument section of the Appeal Brief to separate claims. *See* Appeal Br. 6.



combination of Ha and Yazawa teach a double-walled air conditioner that is received in a single-walled housing 310.” Appeal Br. 6 (emphasis omitted).

Figure 6 of Ha discloses “a receiving hole 320 [] formed on the indoor wall 300 to receive the air conditioner 100.” Ha, Fig. 6, ¶ 55 (emphasis omitted). Ha further discloses that “housing 310 is inserted in the receiving hole and the air conditioner 100 is mounted in the housing 310.” *Id.* In view of our discussion that the Examiner’s proposed combination teaches a window or wall casing with a double-walled, insulated structure, we find that Appellants’ argument is not persuasive of Examiner error and we sustain the rejection of claim 8 and, for the same reasons expressed above, designate our affirmance as a NEW GROUND OF REJECTION.

*Claim 10*

Claim 10 is an independent claim that is substantially similar in scope to claim 1 except that it is recited as a method claim rather than an apparatus claim. Claims App. In rejecting claim 10, the Examiner makes similar findings to that of the rejection of claim 1 discussed above. Non-Final Action 4–5.

Appellants argue only that “the Examiner does not explain why the alleged functional limitation is not entitled to any patentable weight in a method claim.” Appeal Br. 6. Our controlling rule requires that arguments for patentability “shall explain why the examiner erred.” 37 C.F.R. § 41.37(c)(iv). We do not consider Appellants’ conclusory statement to rise to the level of a separate argument for patentability and we sustain the rejection of claim 10 and designate our affirmance as a NEW GROUND OF REJECTION. *Id.*

*Claim 21*

Claim 21 depends from claim 1 and adds the limitation: “wherein said casing is separate from the heating / cooling unit.” Claims App. Appellants argue that Ha and Yazawa, at best, teach a double-walled air conditioner that is separate from a housing 310. Appeal Br. 6. We find this argument unpersuasive for essentially the same reason that we find the argument for claim 8 unpersuasive and we sustain the rejection of claim 21, designating our affirmance as a NEW GROUND OF REJECTION.

*Claims 22 and 24*

Appellants argue that the prior art does not teach that the heating/cooling unit has a housing and that the housing is removably received in the opening of a double-walled casing. Appeal Br. 6. In view of the depiction of air conditioner 100 in Figure 6 of Ha, Appellants’ argument cannot be sustained by the evidence of record and we sustain the rejection of claims 22 and 24, designating our affirmance as a NEW GROUND OF REJECTION.

*Unpatentability of Claims 7, 13, 17, and 18  
over Combinations Based on Ha and Yazawa*

Appellants do not argue for the separate patentability of claims 7, 13, 17, and 18. In view of our decision to sustain the rejection of the independent claims from which of these claims depend, we sustain the rejection of claims 7, 13, 17, and 18, designating our affirmance as a NEW GROUND OF REJECTION.

### DECISION

The Examiner's decision to reject claims 1, 3–8, 10–18, and 20–25 is AFFIRMED, but we designate the affirmance as a NEW GROUND OF REJECTION.

### FINALITY OF DECISION

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless the affirmed rejection is overcome.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED